

**REMARKS**

Claims 24, 27-40, 45, 58-59, 63-69, 71, 73-84, 86 and 88-102 are pending. By this Amendment, claims 24, 59, 68, 71, 83 and 86 are amended and claims 25, 26, 70, 72, 85 and 87 are canceled without prejudice or disclaimer. New dependent claims 100-102 are added, and are generic to the embodiments disclosed in Figs. 8 and 9, and are directed to an eye patch in the state in which it is ready to be applied to a patient's face (e.g., after any release layer has been removed). Reconsideration in view of the following remarks is respectfully requested.

Applicants thank Examiner Brown for the courtesies extended to Applicants' representative during the November 6 telephone interview. The substance of the interview is incorporated in the following remarks.

**The Claims Define Patentable Subject Matter**

A. The Office Action rejects claims 24-25, 27-29, 31-34, 37-38, 40, 45, 58-59, 63-65, 67-71, 73-75, 77, 79-86, 88-90, 92 and 94-99 under 35 U.S.C. §103(a) over U.S. Patent No. 4,790,031 to Duerer in view of U.S. Patent No. 2,283,752 to Gonsett and U.S. Patent No. 5,918,600 to Durette. This rejection is moot in view of the incorporation of the features of former claims 26, 72 and 87 into independent claims 24, 68 and 83, respectively.

B. The Office Action rejects claims 26, 72 and 87 under 35 U.S.C. §103(a) over Duerer in view of Gonsett, Durette and U.S. Patent No. 4,867,146 to Krupnick et al. ("Krupnick"). This rejection is respectfully traversed, and will be addressed as if applied to amended claims 24, 68 and 83.

The Office Action asserts that it would have been obvious to use an adhesive layer as taught by Krupnick in the device of Duerer "in order to use the adhesive to attach the eye patch to the eye socket." Applicants respectfully disagree.

First, Duerer teaches directly and explicitly away from using adhesive to attach an eye protection device to the face. See, e.g., col. 1, lines 32-35, stating that some prior art devices were held in place over each eye "by adhesive tabs attached thereto," and col. 1, lines 43-44, stating that Duerer's invention "overcome [sic] the disadvantages of the prior art eye shields." Thus, Duerer recognizes and teaches that the use of adhesive for attaching an eye protector to the face is to be avoided.

Second, the proposed modification would change the principle of operation of the Duerer device. Specifically, the Duerer device is to be held in place by the use of head straps 14, 15 or 14a, 15a. The head straps are so important to the Duerer device operation that, while recognizing that it might be desirable to avoid encircling the head with the head straps, Duerer accomplishes this with special, weighted head straps 14a, 15a that do not encircle the head. See, e.g., Fig. 6 and col. 4, lines 36-48. Replacing the Duerer head straps with adhesive would clearly violate the rule that "the proposed modification cannot change the principle of operation of the primary reference." See, e.g., MPEP §2143.01.

Third, Krupnick uses an adhesive eye patch to hold the eyelids closed, and thereby to address the problem of drying out of the eyes due to unconscious opening of the eyes while a patient is under anesthesia (see, e.g., col. 1, lines 6-28). In contrast, the device of Duerer is disclosed for use in the context of sun tanning. The user is not anesthetized when sun bathing, and thus there would be no reason to adhere his or her eyelids closed as taught by Krupnick. Thus, one of ordinary skill in the art would have viewed the teachings of Krupnick as inapplicable to the device of Duerer.

For any or all of these reasons, the rejection is in error and should be withdrawn.

C. The Office Actions rejects claims 30, 76 and 91 under 35 U.S.C. §103(a) over Duerer in view of Gonsett, Durette and U.S. Patent No. 4, 969, 472 to Langley et al. ("Langley"); rejects claims 35-36 and 39 under 35 U.S.C. §103(a) over Duerer in view of

Gonsett, Durette and U.S. Patent No. 5,309,925 to Policastro; and rejects claims 66, 78 and 93 under 35 U.S.C. §103(a) over Duerer in view of Gonsett, Durette and U.S. Patent No. 4,709,695 to Kohn et al. ("Kohn"). These rejections are respectfully traversed.

Langley, Policastro and Kohn fail to overcome the above-noted deficiencies of the other applied references with respect to claims 24, 68 and 83. Therefore, claims 30, 35-36, 39, 66, 76, 78, 91 and 93 are allowable at least for their dependence on allowable base claims. Applicants respectfully request withdrawal of these rejections.

D. New claims 100-102 are allowable for their dependence on claims 24, 68 and 83, respectively. Additionally, Duerer discloses two layers of equal size, on respective sides of the layer 26. Therefore, even if the layer 26 were modified to be the "metallic layer" or the "laser-resistant layer" as proposed by the Office Action, the resulting device would not meet the requirement of claims 100-102 that "any layer present on the other side of the metallic layer [or laser-resistant layer] does not overlap the adhesive layer on at least a portion of the periphery of the surface the sheet member."

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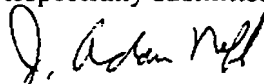
Accordingly, all of the pending claims are patentably distinct from the applied references. Applicants respectfully request reconsideration and withdrawal of the rejections.

### **Conclusion**

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 24, 27-40, 45, 58-59, 63-69, 71, 73-84, 86 and 88-102 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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